

A clean copy of the claims is appended hereto.

## **REMARKS**

### **A. Claim Amendments**

Support for newly added claims 11-13 is supplied by FIG. 8 and page 15, line 21 through page 16, line 3. Support for newly added claims 14-16 is supplied by page 8, lines 13-15 and page 16, lines 23 through 25. Support for newly added claim 17 is supplied by page 16, lines 18-22. It is respectfully submitted that none of these new claims introduce new matter. Moreover, because newly added claims 11-16 depend from claim 1, and because newly added claim 17 is very similar to claim 1, it is not believed that the newly added claims merit a new search.

### **B. Section 112 Rejection**

In an Office Action dated October 4, 2000, the Examiner rejected claims 1-10 under 35 U.S.C. § 112, ¶ 2. Whether a claim is indefinite under 35 U.S.C. § 112, ¶ 2 is a question of law. *Personalized Media LLC v. Int'l Trade Comm.*, 161 F.3d 696, 702-03, 48 U.S.P.Q.2D 1880, 1886 (Fed. Cir. 1998) (citing *North Am. Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571, 1579, 28 U.S.P.Q.2D 1333, 1339 (Fed. Cir. 1993)). "The test for definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification. If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more." *Miles Lab., Inc. v. Shandon, Inc.*, 997 F.2d 870, 875, 27 U.S.P.Q.2D (BNA) 1123, 1126 (Fed. Cir. 1993) (internal citations omitted) (emphasis added).

With respect to claim 1, the Examiner stated that it was not clear how the structure of the foot wrap was further limited by the "concurrent with the introduction of said negative pressure." The Applicants respectfully traverse this rejection. The limitation clearly limits the scope of the

medical apparatus to apparatuses that are able to concurrently apply negative pressure to the wound dressing while applying compressive force to the foot wrap. Medical apparatuses inoperable to concurrently supply negative and positive pressures are not within the scope of the claim.

Incidentally, claim 17 was added to capture apparatuses operable to apply both negative pressure and compressive force to first and second regions, respectively, of a foot, even if such forces are not applied simultaneously.

With respect to claims 2-4, the Examiner stated that "wherein at least some part of said foot wrap overlaps some part of said wound dressing" merely describes intended use. The Applicants respectfully traverse this rejection.<sup>1</sup>

Applicants respectfully disagree that the limitation merely describes intended use. On the contrary, the limitation describes an actual physical relationship between the foot wrap and the wound dressing.

Claim 1 covers any apparatus comprising a wound dressing and foot wrap that are *operable* to apply negative pressure and compressive force, respectively, to first and second regions of a foot, whether or not the foot wrap is operable to overlap the wound dressing. Claims 2-4, by contrast, cover apparatuses in which at least a portion of the foot wrap is not only operable to physically overlap, but *actually* overlaps, at least a portion of the wound dressing.

In light of the specification, it is easy to conceive of apparatuses that would fall within the scope of claim 1 (e.g., (a) an apparatus with a foot wrap and wound dressing, the latter being too large to be overlapped by the foot wrap; (b) an apparatus with a foot wrap and wound

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<sup>1</sup> A search of MPEP chapter 2100 and LEXIS's "Patent Cases, Administrative Decisions, and Regulatory Materials" database (for "'intended use' w/para indefinite") yielded no authority sustaining a section 112 rejection premised on the fact that a claim recited its intended use. It should be noted that "[d]efiniteness does not necessarily require that there be a reason for a limitation, only that one of ordinary skill in the art understands what is claimed." *Brunswick Corp. v. United States*, 34 Fed. Cl. 532, 570 (1995).

dressing, the former being *operable* to overlap the latter, but the former not *actually* overlapping the latter) but that would not fall within the scope of claims 2-4.

Incidentally, newly added dependent claims 11-13 have been added to cover a scope intermediate the scope of claim 1 and the scope of claims 2-4 (i.e., an apparatus with a foot wrap and wound dressing, the former being *operable* to overlap the latter, even if the former is not *actually* overlapping the latter).

Applicants have explained how the challenged limitations define the structure of the claims. In light of these explanations, the Applicants respectfully request withdrawal of the section 112 rejections.

While there may be superior ways of expressing the limitations of claims 1-4, the Applicants are reluctant to amend, in the face of a section 112 rejection, what they believe to be statutorily adequate language, in light of the Federal Circuit's *Festo* holding denying doctrine of equivalents coverage to any claim limitation amended for purposes of patentability. Nevertheless, if the section 112 rejection is withdrawn, the Applicants are amenable to making clarifying amendments proposed by the Examiner, assuming that such proposals do not further restrict the scope of the claims. See MPEP § 2173.02 ("Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.").

### C. Section 103 Rejection

The Examiner rejected claims 1-5 and 10 under section 103(a) as being unpatentable over U.S. Patent No. 5,489,259 to Jacobs et al. in view of G.B. Patent Doc. No. 2,195,255 to Thorn et al. The Examiner also rejected claims 1-10 under section 103(a) as being unpatentable over U.S.

Patent No. 5,443,440 to Tumey in view of Thorn et al. and Jacobs et al. The key reference in each of the rejections is Jacobs et al., which the Examiner cited as teaching towards Applicants' inventive combination of applying compressive force to a foot wrap with negative pressure to a wound dressing. The Applicants respectfully traverse these rejections.

Jacobs et al. states that their invention is "directed to . . . *normalizing the forces* acting on [a] body extremity." Col. 1, lines 22-23 (emphasis added). For added emphasis, Jacobs et al. claims their invention "provides an improved method and article providing protection, support and *pressure normalization* to a human limb, particularly a lower extremity." Col. 1, lines 56-57 (emphasis added). In the background section, Jacobs criticizes "multi-chambered systems . . . because the separate pressurized chambers prevent the displacement of the interior air volume of the device from a region of high pressure to a region of low pressure to thereby *normalize and evenly distribute pressure* applied by the device to the limb." Col. 1, lines 44-48 (emphasis added).

In short, Jacobs et al. teaches the very opposite of Applicants' invention. While Jacobs et al. teaches the application of evenly distributed pressure, Applicants' claims cover devices that simultaneously apply negative pressure and positive compressive force to first and second regions, respectively, of a foot. Far from teaching a combination a compressive foot wrap with a negative-pressure wound dressing, Jacobs teaches away from it.

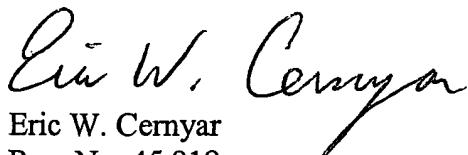
The Examiner correctly noted that Jacobs et al. teaches that its device can be used in conjunction with a wound dressing. On column 6, lines 4-7, of the specification, Jacobs et al. briefly notes that "[t]he releasable securing means thus allows for easy 'put on' and 'take off' of the device 10 and facilitates the changing process of any medical dressings applied to the lower limb . . ."

There are many different kinds of wound dressings, but very few wound dressings are used to introduce negative pressure to a wound. Jacobs et al. does not specifically teach or suggest that a *negative-pressure* wound dressing be applied to the foot. Because Jacobs et al. criticizes multi-chambered systems that unevenly distribute pressure to a lower limb, Jacobs et al. provides no teaching, suggestion, or motivation for combining a compressive foot wrap with a negative-pressure wound dressing. See MPEP § 2143.01 (7<sup>th</sup> ed. Rev. 1) ("If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious."); MPEP § 2145(D)(2) ("It is improper to combine references where the references teach away from their combination.").

#### D. Conclusion

In view of the foregoing arguments, the Applicants respectfully request withdrawal of the section 103 rejections. Believing that all matters raised in the Examiner's October 4, 2000, Office Action have been addressed, the undersigned respectfully requests that the Application be allowed.

Respectfully submitted,



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